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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,892	01/26/2004	Tsutomu Okada	17376	9699

23389 7590 09/13/2005

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EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tuta

Office Action Summary

Application No.

10/764,892

Applicant(s)

OKADA, TSUTOMU

Examiner

Beverly M. Flanagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


 BEVERLY M. FLANAGAN
 PRIMARY EXAMINER

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/26/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement filed January 26, 2004 has been made of record and the references cited therein have been considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (U.S. Patent No. 6,059,719).

In regard to claims 1-7, 11 and 12, Yamamoto et al. teach an endoscope system 1 comprised of an endoscope 2 having an insertion unit 11 with a distal part 16 that is provided with a connecting tool 21 that couples with a connecting tool 8 on an endoscope module 6 (see Figures 1 and 2). Yamamoto et al. teach an embodiment of a module 6A where an incision device 9a comprised of a snare 94 attached to the distal end of an operation tube 23 (see Figure 7). A transmission wire 22 for operating the

snare 94 extends within the tube 23 and is able to move forward and backward (see Figure 7 and col. 10, lines 35-45). First handle 99a and second handle 99b coupled to the proximal end of tube 23 operate the wire 22 and Figures 9-12 and 15 show how the snare 64 projects from the distal end of tube 23 and expands and is stored within the module 6 when slid proximally. **In regard to claim 13**, see col. 10, lines 50-65.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Seuberth et al. (U.S. Patent No. 3,805,791).

In regard to claim 1, Seuberth et al. teach an apparatus for the diathermic removal of growths comprised of a tubular member 2 that houses a loop slider 4 to which is attached a wire loop 5 (see Figure 1). Wire loop 5 is held within the tubular member 2 until actuated by loop slider 4 to protrude from the distal end of the tubular member 2 (see Figures 2-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (U.S. Patent No. 6,059,719) in view of Moriyama (U.S. Patent No. 6,916,284).

In regard to claims 8-10, Yamamoto et al. are silent as to the distal end of module 6 being inclined. However, Moriyama discloses an endoscope hood attached to the distal end of an endoscope where the hood has an inclined distal portion 11 (see Figure 2). Moriyama thus demonstrates that providing a hood attached to the distal end of an endoscope with an inclined surface is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the module 6 of Yamamoto et al. with an inclined surface, such as the one shown by Moriyama.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note the following prior art references disclosing diathermic snares used with an endoscope: Shinozuka, U.S. Patent No. 4,865,017; Hagiwara, U.S. Patent No. 4,374,517 and Nagasaki et al., U.S. Patent No. 4,615,330.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Beverly M. Flanagan
Primary Examiner
Art Unit 3739
